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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,233	03/11/2004	Carlos A. Khantzis	20850.150	8602

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ROZSA LAW GROUP LC
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TARZANA, CA 91356-3346

EXAMINER

STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/800,233	KHANTZIS, CARLOS A.	
	Examiner	Art Unit	
	Anthony Stashick	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
4a) Of the above claim(s) 15-31 and 46-49 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-14 and 32-45 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03112004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 15-31 and 46-49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 23, 2006.

Specification

2. The abstract of the disclosure is objected to because it contains more than the allotted 150 words. Applicant is hereby requested to modify the Abstract to less than 150 words. Correction is required. See MPEP § 608.01(b) part C. Language and Format.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 11, 12, 42 and 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims appear to be improper Markush claims in that they use the term “comprises” instead of “consisting of”. If applicant is not forming these claims as Markush claims, then they are still vague and indefinite because it’s not clear what are the metes and bounds of the claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3-7, 9-14, 32, 34-38 and 40-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bates et al. 5,155,927 in view of Issler 6,922,918. Bates et al. '927 discloses all the limitations substantially as claimed including the following: a shoe 20 having a shoe sole 30, 32, 60 etc. including an outsole 60, a midsole 30, an insole and having a front area over which the toes of a foot rest when the shoe is worn, the improvement comprising: a non-leaking deformable gel 300 (or padding) formed within the front area of the sole and aligned with the insole (located underneath the insole) so that the gel 300 (or padding) is located in the forefoot area of the foot when the shoe is worn, whereby the non-leaking deformable gel permits the toes to curl, flex, bend or grasp downward when a wearer of the shoe is walking; the deformable gel/padding is at least 6mm (see Figures 1 and 2, typical thickness of a midsole); the deformable gel/padding is aligned with a portion of the midsole in addition to being aligned with the insole (see figure 2); a cavity 42 formed into the front portion of the shoe to receive the deformable gel/padding; the shoe is an athletic shoe (see Figures); deformable material is covered with a covering material (see col. 10, lines 3-17). Bates et al. '927 does not disclose the pad being located beneath the toes of the foot so that all five toes rest on the gel and the base of the big toe right below the 1st metatarso-phalangeal joint also rests on the gel as well as the gel being treated with a fungicide. Issler '918 teaches that a pad used in a shoe underneath the toes of the user can be treated with odor absorbents and bactericides (some bactericides function as fungicides) to cushion the user's toes and prevent the buildup of smell within the shoe. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the pad of Bates et al. '927 extend under the user's toes to cushion the toes, as taught by Issler '918, and to treat the pad with a fungicide to prevent the buildup of bacteria, fungus and smell.

7. Claims 2, 8, 33 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied above in view of Grisoni et al. US 2005/0039349 A1 (Grisoni et al. '349). The

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references as applied above disclose all the limitations of the claims except fro the padding or gel being covered with stretch material. Grisoni et al. '349 teaches that gel or padding material located in the forefoot of a shoe can be covered with a covering containing stretch fabrics, such as Lycra, to allow for the covering to have low friction and prevent movement with the user's foot (see end of [0052]).

Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to cover the gel or padding of the references as applied above with Lycra, as taught by Grisoni et al. '349, to prevent the pad from moving when the other layers of the shoe move during use.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are cited on form 892 enclosed herewith.


Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Anthony Stashick
Primary Examiner
Art Unit 3728

ADS